REMARKS

Claims 1-18, 23, 28-30 and 36-40 were previously pending in this application. By this amendment, Applicant is canceling claims 23 and 40. No new claims have been added. Applicant notes with appreciation that claim 5 has been identified as containing allowable subject matter. Claim 5 has been rewritten into independent form to place claim 5 in allowable condition (previously objected to as being dependent on a rejected claim). As a result, claims 1-18, 28-30 and 36-39 are pending for examination with claims 1, 5 and 28 being independent claims. The application as presented is believed to be in condition for allowance.

Summary of Telephone Conference with Examiner

Applicant thanks the Examiner for the courtesies extended in granting and conducting a telephone conference with Applicant's representative on December 20, 2006. Applicant accepts as accurate the summary of the telephone conference provided by the Examiner on December 27, 2006.

Rejections Under 35 U.S.C. §103

Claims 1-4, 8-18, 23, 28-30 and 36-40 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Whitby (UK Patent Application 2 258 201 A) in view of Thomason (U.S. Patent No. 6,018,612). Applicant respectfully traverses the rejection.

Claims 23 and 40 have been canceled. Therefore, the rejection is moot with respect to these claims.

Applicant does not acknowledge that the proposed combination of Thomason and Whitby is proper and reserves the right to argue against the combination in the future, if deemed necessary. However, even if one were to combine Whitby and Thomason as proposed in the Office Action, Applicant's claims patentably distinguish over the combination.

Applicant's independent claim 1 recites, in part, "wherein said replay rate is selected so as to gradually eliminate the delay time...thereby automatically returning said device to

normal mode" (emphasis added). Applicant acknowledges that both Whitby and Thomason disclose both a "live" path and a buffered path for the signal. Whitby discloses a buffered signal can by played back with some time delay, but does not disclose that the buffered signal can be accelerated to catch up with the live program and does not disclose automatically returning to a live mode in which the signal is not played back from the memory. In fact there would be no reason to do so, since based on Whitby's disclosure, the signal never catches up. Thomason discloses that a viewer watching a historical program (i.e., watching a program being supplied from the memory) can "catch up" with the live broadcast by accelerating the playback. However, nowhere does Thomason disclose or suggest that once that viewer has "caught up," the device is automatically returned to a mode in which the program is no longer supplied via the memory. Rather, as noted in the Examiner's interview summary, Thomason is silent as to what happens when playback does actually catch up to the live incoming signal (i.e., when the time delay is eliminated). The Examiner contends that it is obvious or implicit in Thomason that the device will switch back to the "live" path after catching up. Applicant respectfully disagrees.

The MPEP in section 2112 sets forth the requirements to establish a proper rejection based on matter inherent or implicit in the prior art, stating: "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities" (emphasis added) According to the MPEP, and the case law, the mere fact "that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic" (emphasis added). In the present case, although it is possible that in Thomason's system that signal may be redirected to the "live" path once playback has caught up, there is absolutely no indication whatsoever that such switching is necessary. Rather, it is perfectly reasonable to conclude from Thomason's disclosure that either the viewer will continue to watch the program supplied through the buffered path, but with no substantial delay, or that the viewer will have to manually turn off the recorder. Therefore, the limitation recited in Applicant's claim, namely "wherein said replay rate is selected so as to gradually eliminate the delay time...thereby automatically returning said

device to normal mode," is not inherent or implicit in Thomason because it is not necessarily present.

Applicant further asserts that the recitation of claim 1 is also not an obvious extension or modification of Thomason. As discussed above, having the recorder remain and in record and playback mode after catching up to the live broadcast (i.e., the signal is played through the buffered path but with no substantial delay), is a perfectly reasonable and workable manner in which Thomason's system could operate. Thus, there is no reason or motivation suggested by the references to modify the combination of Whitby and Thomason so as to include automatic return to normal mode. The law is clear that in order to combine and/or modify the teachings of prior art references, there must be a clear and definite suggestion or motivation present in the prior art (not in Applicant's disclosure or claims) to make the modification and/or combination. This motivation or suggestion is lacking in the present case due to the facts that Thomason contains no express discussion of what happens when the playback catches up to the live signal, and Thomason discloses that the system can continue to work without being automatically retuned to normal mode.

For at least the reasons discussed above, the tests for both inherency and obviousness fail in the present case and thus, the prior art of record fails to disclose or suggest at least one limitation recited in Applicant's claim 1. Accordingly, withdrawal of the rejection of claim 1 is respectfully requested.

Claims 2-4, 8-18 and 36 depend from claim 1 and are therefore allowable for at least the same reasons as is claim 1. Accordingly, withdrawal of the rejection of claims 2-4, 8-14 and 36 is respectfully requested.

Applicant's independent claim 28 recites a "repeat circuit for use with a radio having a normal mode and a replay mode…wherein said radio is automatically returned from replay mode to normal mode with incoming audio inputs applied to said radio when there is a station change on the radio" (emphasis added). The proposed combination of Whitby and Thomason neither discloses automatic switching between replay and normal modes when the radio station is changed, nor is this feature inherent or "implicit" in the references. Thomason is directed to a television recorder and therefore does not discuss what may happen when a radio station is changed. However, Thomason discussed recording different television channels and

does not disclose or suggest that the device is automatically returned from replay mode to normal mode with incoming inputs applied to the television when there is a channel change on the television. Whitby discloses a radio device and discusses changing the radio station, but also does not disclose or suggest automatically returned from replay mode to normal mode with incoming audio inputs applied to said radio when there is a station change on the radio, as is recited in Applicant's claim 28. As was the case above where Thomason (or the combination of whitby and Thomason) could continue to function when playback "caught up" with the live broadcast without automatically changing the mode of the device (i.e., the signal is simply played through the buffered path with no substantial delay), here too, the device of Whitby and Thomason could also continue to function in the recording/playback mode when the radio station (or TV channel) is changed. The device would simply continue to record and playback the signal now being received from a different channel/station. As discussed in Applicant's previous response, Whitby similarly discloses that when the device is in playback mode, it continues to record (see e.g., page 10, line 12 to page 11, line 18) and thus, it would be perfectly logical to have the device remain in playback mode when the station is changed on the radio. Thus, the recitation in Applicant's claim 28, namely, "said radio is automatically returned from replay mode to normal mode with incoming audio inputs applied to said radio when there is a station change on the radio," is not inherent or implicit in the references because it is not necessary, as required to satisfy the test for inherency discussed above.

Furthermore, this limitation is not an obvious modification of the references. There is nothing in Whitby that discloses or suggests that if the device is a replay mode (i.e., is storing and delayedly playing out audio) that changing the radio station will cause the device to change into a different mode. Simiarly, as discussed above, Thomason also contains no mention or suggestion of this feature. The law is clear that the prior art must contain a definite teaching, suggestion or motivation that would lead one of ordinary skill in the art to either combine to references or modify a reference (or combination of references). This required teaching, suggestion or motivation is completely lacking in the instant case. Although Whitby discloses that a user can tune the radio to change the station (page 5, lines 14-15), Whitby does not link the station change to a change in the mode of the device. This

feature is also not shown in Thomason or any other reference of record, whether taken alone or in combination with Whitby. Furthermore, because the device can continue to operate without being automatically returned to normal mode, there is no reason or motivation to modify it.

Therefore, for at least these reasons, Applicant's claim 28 is patentable over the art of record and withdrawal of the rejection of claim 28 is respectfully requested.

Claims 29, 30 and 37-39 depend from claim 28 and are therefore allowable for at least the same reasons as discussed for claim 28. Accordingly, withdrawal of the rejection of claims 28, 30 and 37-39 is respectfully requested.

Claims 6 and 7 stand rejected under 35 U.S.C. § 103(a) as being upatentable over Whitby and Thomason in further view of Oftedahl (U.S. Patent No. 6,449,768). Applicant respectfully traverses this rejection.

As discussed above, the proposed combination of Whitby and Thomason fails to disclose or suggest at least one limitation recited in Applicant's claim 1, from which claims 6 and 7 depend. Oftedahl fails to cure the deficiencies of Whitby and Thomason because Oftedahl also does not disclose or suggest "wherein said replay rate is selected so as to gradually eliminate the delay time without substantially impairing audio quality of the replayed audio, thereby automatically returning said device to normal mode." Accordingly, even if one were to make the combination of Whitby, Thomason and Oftedahl as proposed in the Office Action, the combination fails to disclose or suggest at least one limitation recited in Applicant's claims and therefore fails to render Applicant's claims unpatentable. Accordingly, withdrawal of the rejection of claims 6 and 7 is respectfully requested.

CONCLUSION

In view of the foregoing amendments and remarks, reconsideration is respectfully requested. This application should now be in condition for allowance; a notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, please charge any such fee to Deposit Account No. 50/2762.

Respectfully submitted,
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